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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,746	05/01/2001	Robert Bartola	257/267	6090

7590

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EXAMINER

DATSKOVSKIY, MICHAEL V

ART UNIT

PAPER NUMBER

2835

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/847,746

Applicant(s)

BARTOLA ET AL.

Examiner

Michael V Datskovskiy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 12-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 03/11/2004 have been fully considered but regarding to the reference by Little they are not persuasive: Little in Figs.17-19 and in col.8, line 38 through col.9, line 30 clearly teaches a carrier for supporting a heat generating chip as a printed circuit board made not only from glass but also from a variety of different materials, and comprising a printed circuit 95 (col.8, line 66). Therefore, the previous rejection over Little stays. Applicant's arguments with respect to the reference by Denney Jr. et al have been fully considered and are persuasive. The rejection over Denney Jr. et al has been withdrawn. However, examiner directs applicant's attention to the previously cited reference by Beise, which discusses a structure almost identical to the device by Denney Jr. et al, but comprising a rigid printed circuit board having channels made within its layers.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Due to an amendment to the parent claim 12, claim 13 now requires a

channel in a layer of a circuit board to include a portion in thermal contact with the heat sink, which is not the case in the proposed invention. Heat sink is a separate part of the design.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 12-44 (claim 13 as best understood by examiner) are rejected under 35 U.S.C. 102(b) as being anticipated by Little.

Little teaches an assembly, Figs.1-19, comprising: a heat generating device 19 or 94 (a chip or a transistor) attached to a multiplayer printed circuit board without a flange (device 19) or through a flange 71 (device 94), and a thermal management system comprising separate heat sink (inherently having an interior lumen) and a pump (condenser and compressor respectively, col.5, lines 40-46) arranged for circulating a coolant through a channel, and a coolant circulation channel loop 29, 31, wherein one part of the loop is formed in a layer of the PCB, and the coolant circulation channel loop is being in fluid and thermal communication with the heat sink (condenser) lumen, and wherein a portion of the coolant cooling channel is in a vicinity of a mounting area of said heat generating device 94. Little teaches furthermore said portion of the channel in the vicinity of the mounting area or the heat generating device is formed by a top

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surface of said circuit board (see Fig.16), and there is a possibility of cooling a plurality of heat generating electronic components (col.10, line 66 through col.11, line 3).

Regarding to the claims 15, 16, 26, 27 and 37: Claims as claiming methods of making said PCB cooling channels (removing of portions of one or more layers – claims 15 and 26, or coinciding vias located in adjacent layers of the PCB – claims 16, 27 and 37) has not been taken in the consideration, because it is well settled that the presence of process limitations in product claims, which product does not otherwise distinguish over the prior art, cannot impart patentability to that product. (In re Johnson, 157 USPQ 670, 1968). Regarding to the claims 17-18 and 28-29 and 38-39: Because the cooling system by Little is a refrigeration system including compressor, evaporator and condenser, examiner assumes that part of a cooling fluid is in a liquid form and part is evaporated to become a gas.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V Datskovskiy whose telephone number is (571) 272-2040. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on ((571) 272-2044. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Michael V Datskovskiy*  
03/30/04

Michael V Datskovskiy  
Primary Examiner  
Art Unit 2835